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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

COLBERT, ELLA

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/848,003	Applicant(s) HALEY ET AL.	
	Examiner Ella Colbert	Art Unit 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44 and 46-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44 and 46-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 44 and 46-49 are pending. Claims 44, 46, and 47 have been amended and claims 48 and 49 have been added in this communication filed 11/12/08 entered as Response after Non-final Action.
2. The duplicate claim objection for claims 44 and 47 is hereby withdrawn in view of Applicants' convincing arguments.
3. The 35 USC 112, First Paragraph rejection is hereby withdrawn for claims 44 and 47 in view of Applicants' pointing out where the recitation is found in the Specification.
4. The 35 USC 112, Second paragraph rejection for claim 44 is hereby withdrawn. The 35 USC 112, second paragraph rejection for claim 45 is considered moot since the claim is/has been cancelled.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 44 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Amended claim 47 recites "... and in connection with the requested ATM transaction;". It is unclear, vague, and indefinite whether Applicants' mean the requested ATM transaction is part of the connection to the ATM or the requested ATM transaction is associated with "the requested ATM transaction".

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“An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed ...”. *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 44, 46, 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,841,118) East et al, hereafter East in view of (US 7,412,223) Yamamoto et al, hereafter Yamamoto.

Claim 44. East discloses, A method of operating an automated teller machine (ATM), the method comprising: a) receiving from a portable device carried by an ATM customer a request to conduct an ATM transaction at the ATM (col. 1, line 46-col. 2, line 43 and col. 4, lines 1-9); c) examining the transaction authorization message which has been received from the portable device carried by the ATM customer to determine if the transaction authorization message is valid (col. 4, line 56-col. 5, line 4) and Yamamoto also discloses this claim limitation in Fig.'s 10A-10K); and d) executing the requested ATM transaction without obtaining any additional authorization message from an authorization center of a financial institution when the transaction authorization message received from the portable device carried by the ATM customer is determined to be valid (col. 5, lines 16-

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31). East failed to disclose, b) receiving from the portable device carried by the ATM customer a transaction authorization message which is associated with the requested ATM transaction and which the ATM customer has obtained from an authorization center of a financial institution before making the requested ATM transaction at the ATM and in connection with the requested ATM transaction.

Yamamoto disclosed, receiving from the portable device carried by the ATM customer a transaction authorization message which is associated with the requested ATM transaction and which the ATM customer has obtained from an authorization center of a financial institution before making the requested ATM transaction at the ATM and in connection with the requested ATM transaction (col. 8, lines 12-23). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Yamamoto in East because such an incorporation would allow East to have a mobile communication system that has a display screen for mobile banking and performing electronic mail and using the Internet for banking service.

Claim 46. East discloses, A method according to claim 49, wherein examining the transaction authorization message includes: comparing a unique transaction program identifier contained in the transaction authorization message with the unique transaction program identifier received from the portable device carried by the ATM customer (col. 4, line 10-col. 5, line 31). East and Yamamoto failed to disclose, determining that the transaction authorization message is valid when the unique transaction program identifiers match; and determining that the transaction authorization message is invalid when the unique transaction

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program identifiers are unmatched. It would have been obvious to one having ordinary skill in the art at the time the invention was made to determine that the transaction authorization message is valid when the unique transaction identifiers match and to determine that the transaction authorization message is invalid when the unique transaction identifiers are unmatched because if the unique transaction identifiers (PIN) matches what is input into the machine or the device the transaction can be authorized but if the unique transaction identifiers (PIN) does not match what is input into the machine or device the transaction cannot be authorized and will be declined.

Claim 47. East discloses, A method of operating an automated teller machine (ATM), the method comprising: a) receiving from a portable device carried by an ATM customer a request to conduct an ATM transaction at the ATM (col. 1, line 46-col. 2, line 43 and col. 4, lines 1-9). East failed to disclose, b) receiving from the portable device carried by the ATM customer a transaction authorization message which is associated with the requested ATM transaction and which the ATM customer has obtained from an authorization center of a financial institution before making the requested ATM transaction at the ATM and in connection with the requested ATM transaction. Yamamoto discloses, b) receiving from the portable device carried by the ATM customer a transaction authorization message which is associated with the requested ATM transaction and which the ATM customer has obtained from an authorization center of a financial institution before making the requested ATM transaction at the ATM and in connection with the requested ATM transaction (col. 8, lines 12-23). It would have been obvious

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to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Yamamoto in East because such an incorporation would allow East to have a mobile communication system that has a display screen for mobile banking and performing electronic mail and using the Internet for banking service. East discloses, c) examining the transaction authorization message which has been received from the portable device carried by the ATM customer to determine if a unique transaction program identifier contained in the transaction authorization message has been modified (col. 4, line 56-col. 5, line 4 and Yamamoto also discloses this in Fig's 10A-10K); and d) executing the requested ATM transaction without obtaining any additional transaction authorization message from an authorization center of a financial institution only when a determination is made that the unique transaction program identifier contained in the transaction authorization message has not been modified (col. 4, line 10-col. 5, line 31).

Claim 48, East discloses, A method according to claim 44, in which the determination of whether the transaction authorization message is valid as in paragraph (c) comprises determining whether said message has been modified (col. 4, line 28-col. 5, line 4).

Claim 49. East discloses, A method according to claim 44, further comprising: receiving from the portable device carried by the ATM customer a unique transaction program identifier which is associated with the requested ATM transaction (col. 5, lines 5-30).

Although the Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action, the specified citations are merely representative of the teachings in the art as applied to the specific limitations within the individual claim. Since other passages and figures may apply to the claimed invention as well, it is respectfully requested that the applicant, in preparing the response, to consider fully the entire references as potentially teaching all of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the Examiner.

Response to Arguments

Applicant's arguments filed 11/12/08 have been fully considered but they are not persuasive.

Issue no. 1: Applicants' argue: The term (phrase) "unique transaction program identifier" appears in the specification, page 10, line 11 which has been considered but is only persuasive in part. Response: The phrase "unique transaction program identifier" is found where Applicant pointed out. However, this page number and line number does not tell what the "unique transaction program identifier" is. Patentee can be his own lexicographer to specifically define terms of a claim contrary to their ordinary meaning does not apply if the written description does not so clearly define the disputed claim term so as to put a reasonable competitor or one reasonably skilled in the art, on notice that patentee intended to so redefine that term". *Process Control Corp. V. HydReclaim Corp.* (CAFC) 52 USPQ2d 1029 (9/7/1999)..

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Issue no. 2: Applicants' argue: The claimed absence of "additional authorization", as claimed in claims 44 (d) and 47 (d) recites "executing the requested ATM transaction without obtaining any additional transaction authorization message from an authorization center of a financial institution when the transaction authorization message received from the portable device carried by the ATM customer is determined to be valid" and 47 (d) recites "executing the requested ATM transaction without obtaining any additional transaction authorization message from an authorization center of a financial institution only when a determination is made that the unique transaction program identifier contained in the transaction authorization message has not been modified" and it is interpreted that East discloses this claim limitation in col. 4, line 10-col. 5, line 31. Col. 4, line 59-col. 5, line 15 recites "if the processor 16 of the ATM accepts the preset coded signal, the person can enter a confidential code in the coded signal, the person can enter a confidential code in the form of a personal identifier ..." -a message has to be present in order for the transaction to be authorized which any phosita would know had to take place even though the words message and messages are not present in the reference.

Issue no. 3: Applicants' argue: The claimed "authorization message" is not found in Yamamoto has been considered but is not persuasive. Response: Yamamoto does discuss the capability of "electronic mail" for performing electronic mail services when using mobile banking" and for performing online transactions with a financial institution which indicates the transaction(s) are with

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a bank. East does disclose an ATM which includes a processor, a signal receiver that is linked to the processor ..." (see abstract).

Issue no. 4: Applicants' argue: There is no expectation of success in combining the references because the rationale, as a matter of logic, does not lead to a combination of the references has been considered but is not persuasive. Response: Case law can be had to *In re Nilssen* (CAFC) 7 USPQ2d 1500 (7/13/1988). "Nilssen urges this court to establish a "reality-based" definition whereby, in effect, references may not be combined to formulate obviousness rejections absent an express suggestion in one prior art reference to look to another specific reference. We reject that recommendation as contrary to out precedent which holds that for the purpose of combining teachings, those references need not explicitly suggest combining teachings, much less specific references". See, e.g., *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983); *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). Also see, *In re Nilssen* (CAFC) 7 USPQ2d 1500 (7/13/1988).

"Claims in a pending application should be given their broadest possible interpretation". *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

February 25, 2009